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GROUP 2600

Gilbert P. Hyatt
P.O. Box 81230
Las Vegas, NV 89180

In re Application of :
Gilbert P. Hyatt :
Application No. 08/464,034 : PETITION DECISION
Filed: June 6, 1995 :
For: IMAGE PROCESSING :
ARCHITECTURE :

This is a decision on the petition filed on April 17, 1996 under 37 CFR 1.181 requesting withdrawal of the Office action, in thirty (30) applications identified in appendix I, to allow applicant to present supplemental preliminary amendments prior to a first Office action.

BACKGROUND

This application was filed on June 6, 1995. A first Office action was mailed on September 26, 1995. A preliminary amendment was filed by applicant September 18, 1995. Since the Office action of September 26, 1995, failed to address that amendment, the action of September 26, 1995, was withdrawn, and a new action was mailed on November 22, 1995. On April 17, 1996, applicant filed the subject petition to withdraw the action of November 22, 1995. On April 22, 1996, applicant filed a response to the Office action of November 22, 1995.

ARGUMENTS

Petitioner has presented several arguments in favor of his request. Namely:

- 1) That he was complying with the Director's request; 2) that the subject applications were examined out of turn; 3) that the action of Group 2600 is inconsistent with the Commissioners customer focus policy; and 4) that applicant had a reasonable expectation of an opportunity to file focused amendments (prior to the first Office action).

DECISION

First, 37 CFR 1.181(f) states that any petition not filed within two months of the action complained of, may be dismissed as untimely. Absent any explanation as to the reasons why the petition was filed five (5) months after the action complained of, the petition is considered untimely.

Next, petitioner has misstated the content of the meeting with Director, Godici, that occurred on October 24, 1995. Petitioner was not asked to file preliminary amendments, nor was he promised a delay in action on any set of applications. It was indicated at that meeting that the Group would act on any preliminary amendments filed prior to the date of our Office action, as is PTO policy, but we would not delay action in any application. Therefore, petitioner's argument with respect to complying with Director Godici's request is without merit.

Next, petitioner states that these applications were examined out of turn. Applications are assigned to examiners' dockets and then examined in turn according to 37 CFR 1.101. In determining order of examination, effective filing dates are considered. See MPEP 708. In this instance, the effective filing date is October 17, 1984 based on the claim for benefit under 35 USC 120, approximately eleven (11) years prior to the action date. Based on this date, the application was certainty ripe for action, on this particular examiner's docket. Furthermore, petitioner should expect to receive an Office action promptly when the invention has been pending via parent applications for eleven years. Thus, to argue that the application was taken out of turn is without merit as viewed against current PTO policy.

While customer service is a tenet that the Commissioner and all PTO employees recognize, delaying action or withdrawing actions serves no useful public purpose other than to delay issuance of any patent rights. While the personnel in Group 2600 stand ready to work with the applicant to identify allowable subject matter and work out issues via any reasonable communications avenue, to request withdrawal of an Office action for a second time after the action had already been reissued once, is unreasonable and simply delays the prosecution of the invention. Applicant presented 77 new claims in the amendment of September 18, 1995. The action on these claims was very thorough, over 33 pages in length. To withdraw that action at this point in time is an unreasonable request upon the Office.

Finally, petitioner had no reason to expect an "opportunity to file focused amendments." As stated previously, the Director indicated that the applications would be acted on in turn based on individual examiner dockets. The subject matter has been before the Office for eleven years. Ninety-seven (97) claims have been presented and addressed in this application. Two Office actions have been rendered. Petitioner's expectation of additional opportunity to present future preliminary amendments,

is not a reasonable request upon the PTO.

In view of the above, Petitioner's request is DENIED.

It is noted that a 2-month extension of time and response to the outstanding Office action was filed on April 22, 1996. This application will be forwarded to the examiner for prompt action on that amendment.

Nicholas P. Godici
Nicholas P. Godici
Director, Group 2600